



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,437	03/18/2002	Claudine Elvire Marie Bruck	BC45226	2415

25308 7590 06/16/2004

DECHERT  
ATTN: ALLEN BLOOM, ESQ  
4000 BELL ATLANTIC TOWER  
1717 ARCH STREET  
PHILADELPHIA, PA 19103

EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

349

<b>Office Action Summary</b>	<b>Application No.</b> 09/937,437	<b>Applicant(s)</b> BRUCK ET AL.	
	<b>Examiner</b> Michael Borin	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 1631

Claims 1-38 are currently pending.

It is noted that claims 35-38 are in "use" format. For the purposes of the restriction requirement, the claims are addressed as method of use claims.

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

Group I, claims 1-7, drawn to polypeptide.

Group II, claims 8-17, 28(b), drawn to polynucleotide, vector, cell, and method of producing polypeptide.

Group III, claims 18,21,22, drawn to polypeptide vaccine.

Group IV, claims 19,21,22, drawn to a polynucleotide vaccine.

Group V, claim 20-22, drawn to cell-containing vaccine.

Group VI, claim 23, drawn to antibody.

Group VII, claim 24, drawn to peptide-based method of screening.

Group VIII, claims 25,26, drawn to peptide-based method of treatment.

Group IX, claims 27, 28 (a), drawn to an agonist.

Group X, claims 27, 28 (a), drawn to an antagonist.

Group XI, claim 28(c), drawn to nucleic acid modulating expression.

Group XII, claim 33 29,30,32, drawn to polynucleotide-based method of diagnostics.

Group XIII, claim 31, drawn to peptide-based method of diagnostics.

Group XIV, claim 33, drawn to polynucleotide SEQ ID No. 3.

Art Unit: 1631

Group XV, drawn to vector-containing vaccine.

Group XVI, claims 35,36, drawn to method of making medicament using polynucleotide.

Group XVII, claims 37,38, drawn to method of making medicament using polypeptide.

The products of Groups I, II, VI, IX, X, XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polypeptides, polynucleotides, antibodies, agonists, and antagonists of said groups are distinct products not having common core structure.

The inventions listed as Groups VI,VII,XI,XIII,XVII are methods of use of product of Group I which do not relate to a single general inventive concept under PCT Rule 13.1. Applicant is entitled to examination of a product, a process of making the product, and process of using the product, provided that claims are linked under Rule 13.2 by a corresponding special technical feature. Applicant is not entitled to examination of multiple processing of using the invention. In the instant case, Group I will be examined together with Group VII.

Art Unit: 1631

Similarly, inventions listed as Groups XII,XVI are separate methods of use of polynucleotides of Group II. Group II, if elected will be examined together with the first method of use, Group XII.

Groups I,II and groups III-V,XV are drawn to patentably distinct products which require differing characteristics. The vaccine compositions requires different host, not required for polypeptides or polynucleotides or cells or vectors, have different pharmaceutical effect, and has separate enablement requirement.

Groups III-V,XV are drawn to patentably distinct products, as vaccines recited in the said groups comprise different components.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (571) 272-0722.

Art Unit: 1631

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0549.

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER

6/11/04

mlb

A handwritten signature in black ink, appearing to read 'Michael Borin', is written over the printed name.